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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,641	01/15/2004	David J. Bender	LEEE 2 00356	5821
27885	7590	05/25/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			KERN, KEVIN P	
			ART UNIT	PAPER NUMBER
			1725	
DATE MAILED: 05/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,641

Applicant(s)

BENDER ET AL.

Examiner

Kevin P. Kerns

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2005 and 02 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 and 22 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No: _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/22/05 & 5/2/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-23 and 26-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gustafson (US 1,929,887), Colella (US 6,051,809), Brofft et al. (US 6,670,580), or Bankstahl et al. (US 6,674,046), in view of either Martin et al. (US 3,720,842) or Lohse (US 3,781,139).

Gustafson discloses an integrated welder, generator, and compressor unit, and a method of using it, such that the unit includes a housing that contains components of a welder, generator 2, air compressor, and internal combustion engine 3; an electric

generator with a connection to welding electrode 4; and a beltless and clutchless connector that connects the air compressor (having associated air receiver tank 46 and pressure monitor and valves) to an auxiliary drive of the internal combustion engine 3, such that the engine 3 drives the generator 2 and air compressor (page 1, lines 1-9 and 62-89; page 2, lines 1-23 and 68-80; page 3, lines 101-106; page 4, lines 63-71; and Figures 1 and 2).

Colella discloses a self-contained integrated welder/generator and compressor apparatus, in which the apparatus 10 includes a housing 14 that contains components of the welder, generator, and compressor; an internal combustion engine 20 mounted in the housing 14; an electric current generator 28 (driven by engine 20) and air compressor 34 mounted inside the housing 14; a connector (belt pulley drive system) connected to an auxiliary drive of the engine 20; electrical and air outlets 66; and an air accumulator (receiver) tank 38 with pressure monitor and valves (abstract; column 2, lines 5-39 and 56-67; column 3, lines 1-67; column 4, lines 1-31; and Figures 1-6).

Brofft et al. disclose a power box that includes an integrated generator, compressor, and welding power supply unit, and a method of using it, such that the unit 10 includes a housing 10c that contains components of a welding power supply 44, generator (alternator unit 42), air compressors (48,50), and internal combustion engine 40; the generator being connected with a connection to engine 40; and a beltless and clutchless connector that connects the air compressors (having associated air accumulator (receiver) tanks 46a,46b and pressure monitor/control panel and valves) to an auxiliary drive of the engine 40 (abstract; column 3, lines 42-67; column 4, lines 1-67;

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column 5, lines 1-10 and 41-67; column 6, lines 1-63; column 7, lines 54-67; column 8, lines 20-67; column 9, lines 1-37; and Figures 1-5).

Bankstahl et al. disclose a portable and fully integrated welder and compressor combination that includes a housing 12 that contains components of the welder combination 10, generator, and compressor; an internal combustion engine 58 mounted in the housing 12; an electric current generator 67 (driven by engine 58) and air compressor 68 mounted inside the housing 12; a connector (belt pulley drive system) connected to an auxiliary drive of the engine 58; electrical and air outlets (36,54); an air accumulator (receiver) tank; and a pressure monitor/control system (26,28) and valves (abstract; column 1, lines 44-67; column 2, lines 1-40; column 3, line 2 through column 6, line 62; and Figures 1-4 and 7).

Neither Gustafson, Colella, Brofft et al., nor Bankstahl et al. discloses the use of an electric plug that is detachably connectable to a receptacle, with the electric plug electrically connected to the air compressor and the receptacle electrically connected to the electric current generator.

However, Martin et al. disclose a transportable refrigeration unit having induction alternator-induction motor reconnection and control system, in which the unit includes an induction machine motor generator 4 that has an electric plug 6 that is detachably connectable to receptacles (8,10), with the receptacles selectively being a transportable attached receptacle 8 or an external power source receptacle 10, such that the electric plug being detachably connectable to these receptacles is advantageous for operating in two modes that include selectively obtaining power from either a self-contained prime

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mover or an external power source (abstract; column 1, lines 13-41; column 2, lines 3-33 and 45-68; column 3, line 1-68; column 4, lines 1-26 and 49-61; column 5, lines 10-24; and Figures 1 and 2).

In addition, Lohse discloses an energy supply unit for freight containers, in which the energy supply unit includes an internal combustion engine, a compressor, and an electric generator, such that generator 25 includes a receptacle to which detachably connectable electric plug 33 connects from the pump (compressor) motor 30, in which the electric plug being detachably connectable to the receptacle is advantageous for selectively providing power to components of the energy supply unit (abstract; column 1, lines 3-5; column 2, lines 3-57; column 3, lines 1-35; and Figure).

It would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify any of the welder/generator/compressor systems of Gustafson, Colella, Brofft et al., or Bankstahl et al., by using an electric plug that is detachably connectable to receptacle(s), as taught individually by Martin et al. and Lohse, in order to operate in two modes that include selectively obtaining power from either a self-contained prime mover or an external power source (Martin et al.; abstract; column 2, lines 3-33; and column 5, lines 10-24), and to selectively provide power to components of the energy supply (Lohse; column 2, lines 3-57; and column 3, lines 30-35).

4. Claims 24, 25, 46, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Gustafson (US 1,929,887), Colella (US 6,051,809), Brofft

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et al. (US 6,670,580), or Bankstahl et al. (US 6,674,046), in view of either Martin et al. (US 3,720,842) or Lohse (US 3,781,139), as applied to claims 1-23 and 26-45 above, and further in view of Di Novo et al. (US 6,596,972).

Gustafson, Colella, Brofft et al., and Bankstahl et al. (individually taken in view of either Martin et al. or Lohse) disclose and/or suggest the elements of claims 1-23 and 26-45 above. Neither Gustafson, Colella, Brofft et al., Bankstahl et al., Martin et al., nor Lohse discloses that the housing has wheels for rolling over a ground surface.

However, Di Novo et al. disclose a welding accessory arrangement for a welder, in which the welder includes a housing 10 that has casters/wheels (250,252) on its base, for the purpose of convenient relocation of the welder to various locations (abstract; column 6, lines 49-51; column 8, lines 4-12; and Figures 1 and 4).

It would have been obvious to one of ordinary skill in the art at the time the applicants' invention was made to modify any of the welder/generator/compressor systems of Gustafson, Colella, Brofft et al., or Bankstahl et al., by using an electric plug that is detachably connectable to receptacle(s), as taught individually by either Martin et al. or Lohse, in order to operate in two modes that include selectively obtaining power from either a self-contained prime mover or an external power source (Martin et al.), and to selectively provide power to components of the energy supply (Lohse), and by further placing casters/wheels on the base of the housing, as disclosed by Di Novo et al., in order to conveniently relocate the welder to various locations (Di Novo et al.; column 6, lines 49-51; column 8, lines 9-12).

Terminal Disclaimer

5. The terminal disclaimer filed on February 22, 2005 and May 2, 2005 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent granted on co-pending US Application Serial No. 10/390,436 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Response to Arguments

6. The examiner acknowledges the applicants' amendments, terminal disclaimer, and two Information Disclosure Statements, all of which were received by the USPTO on February 22, 2005 and May 2, 2005. Both Information Disclosure Statements have been considered and initialed, and copies are provided with this Office Action. The replacement drawing sheet (Figure 3) dated February 22, 2005 is approved, thus overcoming the prior drawing objection. The applicants' amendment has also overcome prior objections to claim 26, as well as prior 35 USC 102(b) and 102(e) rejections. Claims 1-47 remain under consideration in the application.

7. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kevin P. Kerns whose telephone number is (571) 272-1178. The examiner can normally be reached on Monday-Friday from 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dunn can be reached on (571) 272-1171. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kevin P. Kerns *Kevin Kerns 5/22/05*
Primary Examiner
Art Unit 1725

KPK
kpk
May 22, 2005